

REMARKS

Reconsideration and allowance of the present patent application based on the following remarks are respectfully requested.

By this Amendment, claims 1, 7, 10 and 15 are amended. Support for the amendment to the claims may be found throughout the original description and the drawings. No new matter has been added. Accordingly, after entry of this Amendment, claims 1-15 will remain pending in the patent application.

Claims 6, 7 and 10-15 were provisionally rejected under 35 U.S.C. §101 as allegedly claiming the same invention as that of claims 1, 8 and 11-16 of copending Application No. 11/068,040. The rejection is respectfully traversed.

35 U.S.C. §101 prevents two patents from issuing on the same invention. (*See* MPEP 804(II)(A)). However, *per* MPEP 804(II)(A), Applicant respectfully submits that the language “same invention” means identical subject matter. (*See* MPEP 804(II)(A) citing Miller v. Eagle Mfg. Co., 151 U.S. 186 (1984); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957)).

A reliable test for double patenting under 35 U.S.C. §101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent or vice versa, and if so, the claims do not define identically the same invention as required for same invention double patenting. (*See* MPEP 804(II)(A) citing In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970)). MPEP 804(II)(A) clearly indicates that if there is an embodiment of the invention that falls within the scope of one claim, but not the other, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a “halogen” substituent is not identical to or substantively the same as a claim reciting the same compound except having a “chlorine” substituent in place of the halogen because “halogen” is broader than “chlorine.” (*See* MPEP 804(II)(A)).

Bearing in mind these requirements, it cannot be concluded that claims 6, 7 and 10-15 of the present patent application recite identical subject matter as claims 1 and 11-16 of the '040 application. Thus, the statutory double patenting rejection is improper.

For example, claim 6 of the present application recites that the resist mechanism is configured to provide a layer of resist on a target portion of the substrate. By contrast, claim 1 of the '040 application recites that the resist mechanism is configured to provide a liquid layer of resist on a target portion of the substrate. As another example, claim 10 of the

present patent application recites a resist mechanism configured to provide a layer of resist on the substrate. By contrast, claim 11 of the '040 application recites a resist mechanism that provides the layer of resist in a shower-like configuration on the target portion of the substrate. Thus, *per* MPEP 804(II)(A), claims 6 and 10 of the present application are not co-extensive in scope with claims 7 and 11 of the '040 application. Similar conclusions can be drawn for the remaining claims 7 and 11-15 of the present patent application.

Accordingly, reconsideration and withdrawal of the rejection of claims 6, 7 and 10-15 under 35 U.S.C. §101 as allegedly claiming the same invention as that of claims 1, 8 and 11-16 of the '040 application are respectfully requested.

Claims 1-5 and 8 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 1-5 and 9 of copending Application No. 11/068,040.

Without taking a position with respect to the merits or substance of this rejection and while preserving the right to distinguish over the cited reference, which is commonly owned, Applicant submits herewith a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c) to overcome the rejection. Accordingly, Applicant respectfully submits that this rejection is moot.

Claims 1-7 and 10-14 were rejected under 35 U.S.C. §102(e) based on U.S. Pat. No. 7,070,406 to Jeans. The rejection is respectfully traversed.

Claim 1 recites a printing apparatus, comprising, *inter alia*, "a curved member carrying a stationary stamp surface having a plurality of separate curved sides, said stamp surface including a pattern, wherein, in use, said curved member is configured to roll over a substrate to be printed on with said pattern." The cited portions of Jeans do not disclose, teach or suggest these aspects of claim 1.

By way of review, the cited portions of Jeans disclose an apparatus for embossing a flexible substrate with a pattern. The apparatus includes either an optically transparent embossing belt 100 or an optically transparent embossing drum 90 that includes a cylinder 69 (identified by the Office Action as the "curved member" of claim 1). *See* Jeans at FIGS. 38 and 41 and col. 3, lines 48-50, col. 4, lines 55-67 and col. 8, lines 25-37. In operation, a movable flexible substrate 101 is moved using a plurality of rollers under the surface of either the rotating belt 100 or the rotating drum 90. *See* Jeans at FIGS. 38 and 40 and col. 4, lines 3-7 and col. 8, lines 38-48.

With this said, the cited portions of Jeans do not disclose, teach or suggest that either the embossing belt 100 or the cylinder 69 (identified by the Office Action as the "curved

member" of claim 1) carries a stationary stamp surface having a plurality of separate curved sides, the stamp surface including a pattern, wherein, in use, the curved member is configured to roll over a substrate to be printed on with said pattern. Quite to the contrary, the embossing belt 100 of Jeans has a movable stamp surface, while the cylinder 69 of Jeans has a cylindrical surface. Therefore, unlike claim 1, neither the belt 100 nor the cylinder 69 carries a stationary stamp surface having a plurality of separate curved sides. Therefore, for at least this reason, the cited portions of Jeans do not disclose, teach or suggest each and every feature recited in claim 1 and, as a result, cannot anticipate this claim.

Claims 2-7 are patentable over the cited portions of Jeans at least by virtue of their dependency from claim 1 and for the additional features recited therein.

Claim 10 is patentable over the cited portions of Jeans for at least similar reasons as provided above for claim 1 and for the features recited therein. For example, the cited portions of Jeans do not disclose, teach or suggest a printing apparatus for nanometric scale imprinting, comprising, *inter alia*, "a curved member carrying a stationary stamp surface having a plurality of separate curved sides, said stamp surface including a pattern wherein, in use, said curved member is configured to roll over a substrate to transfer said pattern onto said substrate."

Claims 11-14 are patentable over the cited portions of Jeans at least by virtue of their dependency from claim 10 and for the additional features recited therein.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-7 and 10-14 under 35 U.S.C. §102(e) based on Jeans are respectfully requested.

Claims 8 and 15 were rejected under 35 U.S.C. §103(a) based on Jeans in view of U.S. Pat. No. 6,362,804 to Hamilton. The rejection is respectfully traversed.

Claims 8 and 15 are patentable over the cited portions of Jeans at least by virtue of their dependency from claims 1 and 10, respectively, and for the additional features recited therein.

The cited portions of Hamilton fail to remedy the deficiencies of Jeans. The cited portions of Hamilton disclose a method of making a cathode ray tube with an integral light trapping filter. The filter of Hamilton is assembled in the following manner. A face plate 104 is mounted on a suitable support 106. Guide pins 108 are formed on the interior concave surface of the face plate 104. A film of emulsion 110 is laid down directly on the inner wall 112 of face plate 104. A spherically curved mask 114 (identified by the Examiner as the "curved member" of claim 1) is provided with guide apertures 116 which fit accurately on guide pins 108. *See* Hamilton at col. 7, lines 10-31 and FIG. 17. With this said, the cited

portions of Hamilton do not disclose, teach or suggest a printing apparatus, comprising, *inter alia*, "a curved member carrying a stationary stamp surface having a plurality of separate curved sides, said stamp surface including a pattern, wherein, in use, said curved member is configured to roll over a substrate to be printed on with said pattern", as recited in claim 8 or a printing apparatus for nanometric scale imprinting, comprising, *inter alia*, "a curved member carrying a stationary stamp surface having a plurality of separate curved sides, said stamp surface including a pattern wherein, in use, said curved member is configured to roll over a substrate to transfer said pattern onto said substrate", as recited in claim 15. Therefore, any proper combination of the cited portions of Jeans and Hamilton cannot result, in any way, in the invention of claims 8 and 15.

Accordingly, reconsideration and withdrawal of the rejection of claims 8 and 15 under 35 U.S.C. §103(a) based on Jeans in view of Hamilton are respectfully requested.

All rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

If any point remains in issue which the Examiner feels may be best resolved through a personal or telephone interview, please contact the undersigned at the telephone number listed below.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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